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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,362	01/05/2004	Radhakrishnan Janardanan Nair	AA611	2195
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			EXAMINER CHAPMAN, GINGER T	
			ART UNIT 3761	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/751,362

Applicant(s)

NAIR ET AL.

Examiner

Ginger T. Chapman

Art Unit

3761

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 9, 22-30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 25-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 9, 22-24, 30 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 24, 2009 has been entered.

Status of the claims

2. Claims 1, 9, 11, 22-30 and 32 are pending in the application, independent claims 1 and 30 are amended, claims 25-29 are withdrawn from consideration as being drawn to a nonelected invention, claims 1, 9, 11, 22-24, 30 and 32 are examined on the merits.

Response to Arguments

1. Applicant's arguments filed August 18, 2009 have been fully considered but they are not persuasive.

2. Applicant argues that independent claims 1 and 30 are amended to recite the limitation that "the printed graphics are printed directly on each backsheet of the n absorbent articles in a randomly selected order". Applicant submits this amendment distinguished over Pargass because Pargass teaches articles with repeating graphics and teaches printing the graphics on a patch which is then affixed to the nonwoven comprising the backsheet of the diaper.

3. This argument is not persuasive because, as detailed *infra*, Pargass is cited under 35 USC 103(a) for teaching the limitations of a printed graphic printed directly on the garment contacting surface comprising the outer layer of the backsheet wherein the printed graphic of each of the n

absorbent articles is different from the graphic of each of the remaining absorbent articles and all of the printed graphics of the n absorbent articles have a predetermined association. Yeo is cited for the teachings of printing the graphics directly on the backsheet, while Stavrulov is cited for teaching randomly and non-randomly selected orders, as detailed *infra*. Pargass, Yeo and Stavrulov are all analogous art concerned with providing diapers with graphics in packages in manners which are attractive to a consumer to motivate purchasing thereof.

4. Applicants' arguments drawn to the claims as amended are further answered in the detailed analysis of the rejected claims below. Therefore the examiner respectfully traverses Applicants arguments and maintains the art rejections of the rejected claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1, 9, 11, 22-24, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pargass et al (US 6,558,499) in view of Yeo (US 5,503,076) and further in view of Stavrulov (WO 00/13632).
6. With respect to claims 1 and 30, Pargass et al disclose an absorbent product (10) comprising a package and at least n absorbent articles contained in the package, wherein n is greater than 10 (column 5, lines 3-5), each of the absorbent articles having a body contacting surface (14) and a garment contacting surface (22) opposing the body contacting surface, each of the absorbent articles comprising: a component material (26) (c. 7, l. 54; fig. 3; c. 8, l. 27) disposed between the body contacting surface (14) and a garment contacting surface (22), the component material (26) having a printed graphic (21, 21') printed directly on the garment contacting surface comprising the outer layer of the backsheet (figs. 1 and 2); wherein the printed graphic (21, 21') of each of the n absorbent articles is different from the graphic of each of the remaining absorbent articles (c. 15, ll. 44-52 and c. 15, ll. 60 to c. 16, ll. 1-2) and all of the printed graphics (21, 21') of the n absorbent articles have a predetermined association (c. 10, ll. 17-21; see also c. 6, ll. 59; c. 7, ll. 12-15; c. 10, ll. 36-37). See also c. 2, ll. 9-13, disclosing that printed graphics having a predetermined association are known in the diaper art.
7. Pargass discloses the claimed invention except for the predetermined association includes a common theme and the articles are stacked in the package in a randomly selected order. The limitation of a "predetermined association includes a common theme" is not a structural limitation of the article and therefore does not serve to further limit the article.
8. The dictionary definition of "predetermined" is "to decide something at an earlier time" (Cambridge International Dictionary of English). The dictionary definition of "association" is,

inter alia: something linked in memory or imagination with a thing or person; the process of forming mental connections or bonds between sensations, ideas, or memories (Merriam-Webster Online Dictionary). The dictionary definition of “theme: is “a subject or topic of discourse or of artistic representation; a specific and distinctive quality, characteristic or concern (Merriam-Webster Online Dictionary). Therefore the limitation of a predetermined association including a common theme is not a structural limitation of the article but rather is drawn to a mental process and therefore does not lend additional patentable weight.

9. Pargass discloses the claimed invention except for the articles are stacked in the package in a randomly selected order. The order in which the diaper articles are placed in the package is not a structural limitation of the product but is a matter of intended use. In apparatus, article and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See MPEP § 2111.02. The intended use may further limit the claim if it does more than merely state purpose or intended use.

10. The decision of how to package the diapers in randomly selected orders or non-randomly selected orders is the result of a mental process, i.e. selecting how to distribute and sell the diapers is a marketing strategy of offering for sale products packaged in a manner which makes the purchase thereof attractive to a consumer. For example, the diapers in the package can be taken out of the package and rearranged in an entirely different non-random or random order then replaced into the package; each diaper can also be provided in a single package. The structural elements of the diapers do not change because their order in the package is changed

thus the order in which the diapers are placed in the package is irrelevant to the diaper structure. Therefore this limitation does not lend additional patentable weight.

11. If products were patented based on simply changing the order in which they are placed in a package, multiple patents could issue indefinitely for the same product merely by placing them in a package in a different order.

12. Finally, the articles or Pargass are fully capable of being placed in a package in a randomly selected order.

13. Pargass discloses the claimed invention except for the backsheet of each of the articles comprises a microporous film material wherein the graphic is printed directly on the garment facing surface of the film and the backsheet further comprises a nonwoven material joined with the garment facing surface of the film and the graphic is visible through the film. As best depicted in Figure 1, Yeo teaches a diaper 20 backsheet 40 comprising a microporous film (c. 5, ll. 49-50) with graphics printed directly on the garment facing surface of the film (c. 8, ll. 44-48; teaching it is preferable to print directly on the film surface because it is smoother than the non-woven surface and therefore permits greater print pattern definition) and the printed graphic is visible through the non-woven material (c. 4, ll. 22-23);

14. and the backsheet 10 further comprises a nonwoven material 12 joined with the film and the graphic is visible through the nonwoven (c. 4, ll. 22-24). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the backsheet of Pargass as taught by Yeo since Yeo states, at c. 8, ll. 45-47 and at c. 4, ll. 26-27, that the advantage of forming the article with this design is that the microporous film provides a

smooth surface to support multi-colored printed graphics and the nonwoven protects the graphic from abrasion and provides a more cloth-like look and feel to the outer surface of the diaper.

15. Pargass discloses the claimed invention except for the printed graphics are printed in a randomly selected order. The examiner notes the dictionary definition of "random":

16. Main Entry: **·ran-dom**

17. Pronunciation: \ˈran-dəm\

18. Function: *noun*

19. Etymology: Middle English, succession, surge, from Anglo-French *randun*, from Old French *randir* to run, of Germanic origin; akin to Old High German *rinnan* to run — more at [RUN](#)

20. Date: 1561

: a haphazard course

— **at random** : without definite aim, direction, rule, or method <subjects chosen *at random*>

21. (source: Merriam Webster Online Dictionary).

22. Stavrulov teaches absorbent articles comprising graphics wherein the graphics are printed in a randomly selected order. Stavrulov teaches that the graphics can be either in a randomly selected order or non-randomly selected order as desired by the designer depending on the intended end use, i.e. such as graphics for informational, educational, and instructive or for entertainment and amusement, and the number of articles being provided to the consumer. Stavrulov teaches non-random graphics such as: graphics and text linked by common subjects, ideas, a series of pictures linked by a common plot (p. 5, p. 9), and consecutive stages from Disney cartoons (p. 11), i.e. a story told in sequential order which is not random.

23. Stavrulov teaches random graphics such as fragments of text and titles of literary works (p. 2), interesting trivia facts and observations, advice given – advice given would necessarily be

random since the particular advice provided in any given graphic would not be related in any way to any particular situation the consumer may need to be advised in at the moment they encounter any particular graphic (p. 5); puzzles and rebuses, conundrums, patterns (patterns can be ordered patterns or random patterns, and can be abstract meaningless patterns), ornaments (p. 5); independent images, which suggests images not associated with each other in any way (p. 8); graphics of automobile models, breeds of trees, architectural monuments, textual fragments (p. 9); unequal ornaments and riddles with a degree of dissimilarity and which do not coincide with each other (p. 11).

24. Stavrulov teaches that the type of graphics and their random or non-random nature depends on the prospective purpose and kinds of households the graphics are intended to attract. Stavrulov further teaches that these graphics can have a positive effect of the emotions of a consumer to attract the consumer to purchase and enjoy the articles (p. 4) and that if the graphics become familiar and routine, the attractiveness to the consumer may diminish with time (p. 3), thus providing motivation for a degree of randomness to keep the articles and graphics exciting for the purchasers thereof.

25. Therefore, in view of the teachings of Stavrulov, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the graphics of Pargass in either randomly selected order or in non-randomly selected order in order to provide the benefits Stavrulov discloses. The examiner notes that when there is an almost limitless variety of possible graphics to choose from, the choices illustrate that the graphics provided is purely a matter of choice; when there is a variety of possible choices, it means that the designer can choose any graphics in any order that he wants.

26. The examiner notes that the limitation of how the graphic is printed refers to the method of printing and does not change the structure of the article having a printed graphic on it.

27. With respect to claim 9, reciting the themes include cartoon characters and other various themes, this limitation is drawn to the content of the printed matter graphics. With respect to printed matter, the critical question is whether any new and unobvious relationship functional relationship exists between the printed graphic and the substrate, as per MPEP § 2112.01, III. Here, both the instant and the prior art graphics are printed on microporous film with nonwoven material comprising the outer cover of the article and the printed graphic is visible through the nonwoven. Outer covers are known in the art to comprise laminates of films and nonwovens in multiple layers, and therefore the claimed graphics do not define any new and unobvious functional relationship between the printed matter and the substrate. Therefore the prior art anticipates the claimed limitation in accordance with § MPEP 2112.01, III, as reproduced *infra*.

III. PRODUCT CLAIMS – NONFUNCTIONAL PRINTED MATTER DOES NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE IDENTICAL PRIOR ART PRODUCT

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of

patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." MPEP § 2112.01, III.

28. It is well known in the packaging art to provide packaging elements with ornamental graphical and product information to induce potential consumer interest. Therefore the selection of graphics would have been within the level of ordinary skill and obvious for the reason of providing advertisement, identification or information about the product or ornamental graphics to induce consumer interest in the article. Additionally, the content of the graphics is purely a matter of choice, when there is a variety of possible graphics, it means the designer can choose whatever graphics he desires. Therefore the theme, i.e. content of the graphics does not lend additional patentable weight because if articles were patented based on differences in graphics, multiple patents could issue indefinitely for the same article by simply changing the content of the graphic.

29. With respect to claim 11, Pargass et al disclose n is selected from 11 to 120 (c. 5, ll. 4-5)

30. With respect to claims 22 and 32, Pargass discloses the claimed invention except for inkjet printed graphics. Yeo teaches inkjet graphics (c. 9, ll. 7-9). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the graphics of Pargass by inkjet printing as taught by Yeo since Yeo states, at c. 8, ll. 66-67 and c. 9, ll. 5-10, that the advantage of using inkjet printing is that the process can handle multi-color printing and can print directly on a microporous film with no fouling of equipment and provides bright colors and sharp patterns.

31. With respect to claims 23 and 24, Pargass discloses the claimed invention except for the sheet of material extending from the first to second waist region is microporous film and the

graphic is printed directly on the garment facing surface of the film as recited in claim 23, and a nonwoven material joined with the garment facing surface of the film and the printed graphic is visible through the material. As best depicted in Figures 2 and 3, Yeo teaches microporous film 14 and the graphics (fig. 3) printed directly thereon, a nonwoven material 12 joined thereto and the graphic is visible through the material 12 (c. 4, ll. 20-30). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the article of Pargass as taught by Yeo since Yeo states, at c. 4, ll. 21-30, that the advantage of forming the article with this design is that it provides colorful graphics which are visually appealing; the microporous film provides a smooth surface to support multi-colored printed graphics and the nonwoven protects the graphic from abrasion and provides a more cloth-like look and feel to the outer surface of the diaper.

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
33. Sebastian (US 2005/0186416 A1) teaches microporous film and non-woven backsheet [0037] and inkjet printing on the film.
34. Weber et al (US 6,352,528 B1) teaches microporous film and non-woven backsheet [0037] and inkjet printing on the film.
35. McCormack (US 6,719,742 B1) teaches inkjet printing on microporous film and non-woven.
36. Reed et al (WO 99/60973) and (WO 99/32164): teaches graphics printed on backsheet of diapers wherein the backsheet comprise microporous film material wherein the graphic is

printed directly on the garment facing surface of the film and the backsheet further comprises a nonwoven material joined with the garment facing surface of the film and the graphic is visible through the film.

37. Schleinz et al (US 5,458,590) teaches graphics printed on backsheets of diapers wherein the backsheets comprise microporous film material wherein the graphic is printed directly on the garment facing surface of the film and the backsheet further comprises a nonwoven material joined with the garment facing surface of the film and the graphic is visible through the film.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T. Chapman whose telephone number is (571)272-4934. The examiner can normally be reached on Monday through Friday 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ginger T Chapman/

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Examiner, Art Unit 3761

08/27/09

/Tatyana Zalukaeva/

Supervisory Patent Examiner, Art Unit 3761